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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,269	12/30/2003	Forrest Rhoads	962.016US1	9691
21186 7590 06/04/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
SYED, FARHAN M				
ART UNIT		PAPER NUMBER		
2165				
MAIL DATE		DELIVERY MODE		
06/04/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/751,269

**Applicant(s)**

RHOADS ET AL.

**Examiner**

FARHAN M. SYED

**Art Unit**

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 15-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 1-21 are pending.
2. Claims 15-21 are withdrawn from consideration.

***Response to Remarks***

3. Prosecution is reopened as a response to pre-appeal request filed on 11 March 2008 and a subsequent decision mailed on 02 April 2008. Therefore, the Applicant's request for reconsideration of the finality of the rejection of the last Office action, mailed 06 September 2007, is withdrawn.

4. Applicant's election with traverse of claims 15-21 in the reply filed on 15 June 2007 is acknowledged. The traversal is on the ground(s) that claims 15-21 are elected based on original presentation. This is not found persuasive because the scope of the claims addressed different embodiments such as claim 1 recites the limitations of a computer system comprising: means for receiving a query from an agent of a law firm; means, responsive to the received query, for searching at least first and second physical or logical databases for content related to the query, with the first database including work-product documents of the law firm and the second database including non-work product documents.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Objections***

5. Claims 10-14 are objected to because of the following informalities: Claim 10 has no separation between the preamble and the body of the claim, as it appears to be one long paragraph which is not proper construction of method claims. For similar reasons, claims 11-14 are objected. See MPEP 608.01(i). Appropriate correction is required.
6. Claim 13 is objected to because of the following informalities: In line 1 of claim 13, the term '(specification)' is used to provide additional description for a browser-compatible user interface. The Examiner is unsure as to why it is there, as the Examiner assumes that the browser-compatible user interface would in fact be described in the Applicant's disclosure. Appropriate correction is required.
7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 12 recites 'a machine-readable medium,' which is not supported by the Applicant's disclosure. For the purpose of examination, the definition of machine-readable medium is taken to include only statutory embodiments.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 13 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 13 recites a 'browser-compatible user interface,' which the Applicant describes in the disclosure, see page 5, lines 19-24, which state "...includes one or more or more search engines, and other modules and software, such as browser-compatible user-interface elements (UIEs) for receiving and fulfilling queries from clients." The Examiner interprets browser-compatible user-interface as software *per se* and therefore is non-statutory.

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal,

does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Rivette et al (U.S. Patent No. 5,991,751 and known hereinafter as Rivette).

As per claim 1, Rivette teaches a computer system comprising: means for receiving a query from an agent of a law firm (i.e. “Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.”)(Column 28, lines 28-35); means, responsive to the received query (i.e. “The searching module 410 in the enterprise server 314 receives the query request 908A.”)(Column 29, lines 52-54), for searching at least first and second physical or logical databases for content related to the query (i.e. “The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304,

306.")(Column 25, lines 39-42), with the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm (i.e. "The present invention also maintains one or more groups. Each of the groups comprises any number of patents from the first databases.")(Column 3, lines 64-66) and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories (i.e. "The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 2, Rivette teaches a system, wherein the first and second databases are separated by a firewall (i.e. "The security module 402 performs the steps of flowchart 11002 to determine whether a user who is requesting an operation involving a data item has sufficient security access privileges with respect to that data item. Preferably, all operations performed by the enterprise server 314 are security checked. In other embodiments, only some operations performed by the enterprise server 314 are security checked. For example, operations involving reading patent documents are not security checked in some embodiments because patents are widely available public documents.")(Column 82, lines 1-10).

As per claim 3, Rivette teaches a system: wherein the work product documents include briefs, client correspondence, advisory opinions, or legal memoranda produced by the law firm (i.e. "Each of the groups comprises any number of patents from the first databases.")(Column 3, lines 64-66); and wherein the second databases are part of an online pay-for-access legal research service (i.e. "The present invention, upon receiving appropriate

operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 4, Rivette teaches a system, wherein the means for receiving a query includes a graphical user interface for displaying a taxonomy of selectable legal topics, with selection of one or more of the legal topics indicative of a query being received (i.e. "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface GUI 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 26, lines 60-67).

As per claim 5, Rivette teaches a system: wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of the documents found by the means for searching, with each displayed portion associated with an indicator of whether the document is a work-product document of the law firm and with a depth-of-treatment indicator indicating a degree of treatment of the legal case within the document (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the



patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 6, Rivette teaches a system, wherein each displayed portion associated with an indicator that indicates the document is a work-product document is further associated with information identifying an author of the document, an office location of the author, and an identification of documents within a document management system for the law firm (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 7, Rivette teaches a system, wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for

displaying at least a portion of each document found by the means for searching, with each displayed portion associated with: a selectively displayable table of authorities listing documents cited within the document; a selectively displayable listing of other documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.") (Column 69, lines 66-67; column 70, lines 1-11); a selectively displayable listing of work-product documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.") (Column 69, lines 66-67; column 70, lines 1-11).

As per claim 8, Rivette teaches a system, wherein each listed document is associated with a depth-of-treatment indicator indicating a quantitative and/or qualitative degree to which the listed document treats the legal case and one or more of the listed

work-product documents are associated with a feedback indicator selectable to view one or more user comments on the one or more listed work-product documents (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.") (Column 69, lines 66-67; column 70, lines 1-11).

As per claim 9, Rivette teaches a system, wherein each portion of the documents found by the means for searching includes a selection device for invoking display of text of the document, with text including one or more selectable citations to other corresponding documents and with each citation associated with an indicator of current reliability of its corresponding document as a legal authority (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.") (Column 69, lines 66-67; column 70, lines 1-11).

As per claims 10-14, Rivette teaches a system comprising providing an interface for an online legal research service, wherein the interface enables an authorized law firm user to view search results (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.")(Column 28, lines 28-35) including both internal law-firm content including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and content of the online legal research service, wherein the search results are based on a single query submitted or initiated through the interface by the user (i.e. "The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306." "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface (GUI) 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 25, lines 39-42; column 26, lines 60-67).

As per claim 11, Rivette teaches the method wherein the law-firm content is stored in a law-firm information management system (see item 302, Figure 3) that includes a document management system (i.e. document databases)(see Figure 6) for the law firm (i.e. user)(Figure 2) and is separated from the online legal service by a firewall (i.e. Network)(Figure 3).

12. Claims 1-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rivette et al (U.S. Patent No. 5,991,751 and known hereinafter as Rivette).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rivette et al (U.S. Patent No. 5,991,751 and known hereinafter as Rivette) in view of Barney et al (U.S. Patent No. 6,556,992 B1 and known hereinafter as Barney).

As per claim 1, Rivette teaches a computer system comprising: means for receiving a query from an agent of a law firm (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.")(Column 28, lines 28-35); means, responsive to the received query (i.e. "The searching module 410 in the enterprise server 314 receives the query request 908A.")(Column 29, lines 52-54), for searching at least first and second physical or logical databases for content related to the query (i.e.

" The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306."(Column 25, lines 39-42), with the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm (i.e. "The present invention also maintains one or more groups. Each of the groups comprises any number of patents from the first databases.")(Column 3, lines 64-66) and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories (i.e. "The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

Rivette does not explicitly teach the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories.

Barney teaches the first database being a part of an information management system for the law firm (i.e. "a first database") (column 11, lines 1-67) including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm (i.e. "*Such information might include prior art that was not cited in the patent, possible license terms, potential problems with the written description or claims of the patent, information about the inventors, information relating to sales of patented products prior to the filing date, legal opinions, related litigation, and any other information that might be relevant to the patent.*") (column 11, lines 1-67) and the second database (i.e. "a second database") (column 11, lines 1-67) being external to the information

management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories (i.e. *"Examples of indirect patent metrics include reported patent litigation results, published case opinions, patent licenses, marking of patented products, and the like."*) (column 11, lines 1-67).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to modify the teachings of Rivette with the teachings of Barney to include the first database being a part of an information management system for the law firm including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and the second database being external to the information management system and including case opinions, court documents, law review articles, statutory materials, or legislative histories with the motivation to improve management and leveraging of accumulated knowledge within law-firm document collections.

As per claim 2, Rivette teaches a system, wherein the first and second databases are separated by a firewall (i.e. "The security module 402 performs the steps of flowchart 11002 to determine whether a user who is requesting an operation involving a data item has sufficient security access privileges with respect to that data item. Preferably, all operations performed by the enterprise server 314 are security checked. In other embodiments, only some operations performed by the enterprise server 314 are security checked. For example, operations involving reading patent documents are not security checked in some embodiments because patents are widely available public documents.")(Column 82, lines 1-10).

As per claim 3, Rivette teaches a system: wherein the work product documents include briefs, client correspondence, advisory opinions, or legal memoranda produced by the law firm (i.e. "Each of the groups comprises any number of patents from the first databases.")(Column 3, lines 64-66); and wherein the second databases are part of an online pay-for-access legal research service (i.e. "The present invention, upon receiving appropriate operator commands, automatically processes the patents in one or more of the groups in conjunction with non-patent information from the second databases.")(Column 3, lines 66-67; column 4, lines 1-2).

As per claim 4, Rivette teaches a system, wherein the means for receiving a query includes a graphical user interface for displaying a taxonomy of selectable legal topics, with selection of one or more of the legal topics indicative of a query being received (i.e. "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical user interface GUI 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57.")(Column 26, lines 60-67).

As per claim 5, Rivette teaches a system: wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of the documents found by the means for searching, with each displayed portion associated with an indicator of whether the document is a work-



product document of the law firm and with a depth-of-treatment indicator indicating a degree of treatment of the legal case within the document (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 6, Rivette teaches a system, wherein each displayed portion associated with an indicator that indicates the document is a work-product document is further associated with information identifying an author of the document, an office location of the author, and an identification of documents within a document management system for the law firm (i.e. " The field driven GUI 5702 of FIG. 57 is similar to that of FIG. 53. Note that the GUI 5702 of FIG. 57 includes a keywords field 5716, which allows the user to search through user-definable fields in the patent bibliographic databases 604. The field driven GUI 5702 of FIG. 57 also allows the user to define the scope of the search via fields 5728. In the example of FIG. 57, the scope of the search can be the full text index (i.e., a search of the patent bibliographic information), only the patents stored in the patent database 614 (i.e., only the patents in the customer's patent repository), only the patents in the current group, or only the current patent. Other embodiments may restrict searching to specific types of documents or specific predefined groups, such as all European

patents, all PCT applications, all non-patent documents, documents in BOM groups, etc.")(Column 28, lines 13-28).

As per claim 7, Rivette teaches a system, wherein the query includes an identification of a legal case (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902.")(Column 28, lines 28-31); and wherein the system further comprises means for displaying at least a portion of each document found by the means for searching, with each displayed portion associated with: a selectively displayable table of authorities listing documents cited within the document; a selectively displayable listing of other documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11); a selectively displayable listing of work-product documents citing the document (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more

particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 8, Rivette teaches a system, wherein each listed document is associated with a depth-of-treatment indicator indicating a quantitative and/or qualitative degree to which the listed document treats the legal case and one or more of the listed work-product documents are associated with a feedback indicator selectable to view one or more user comments on the one or more listed work-product documents (i.e. "A user can view a document by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claim 9, Rivette teaches a system, wherein each portion of the documents found by the means for searching includes a selection device for invoking display of text of the document, with text including one or more selectable citations to other corresponding documents and with each citation associated with an indicator of current reliability of its corresponding document as a legal authority (i.e. "A user can view a document

by double-clicking (or use any other well known GUI technique) on that document in the window 1804. In the example of FIG. 18, the user has selected document D1 (indicated by dotted circle 1852). This results in the document being displayed in a window 1806. The window 1806 includes a window 1808, where the text of document D1 is displayed, and/or a window 1810, where the image of document D1 is displayed. The example of window 1806 where text and images of a document are selectively displayed is more particularly shown in FIG. 112. An example of screen shot 1801 where the user-defined group hierarchical structure is shown in one window 1802 and a list of documents is displayed in another window 1804 is more particularly shown in FIG. 58.")(Column 69, lines 66-67; column 70, lines 1-11).

As per claims 10-14, Rivette teaches a system comprising providing an interface for an online legal research service, wherein the interface enables an authorized law firm user to view search results (i.e. "Referring again to FIG. 9, the client searching module 710 generates a query request 908A based on the search criteria that the user entered into the field driven GUI 902. Preferably, this query request 908A is in the native query language of the enterprise server 314. In other words, the query request 908A conforms to the enterprise server API.")(Column 28, lines 28-35) including both internal law-firm content including briefs, client correspondence, advisory opinions, or legal memoranda of the law firm and content of the online legal research service, wherein the search results are based on a single query submitted or initiated through the interface by the user (i.e. "The searching module 410 in the enterprise server 314 interacts with a search engine 424 to conduct searches through the data in the databases 316 pursuant to search requests from the clients 304, 306." "The operation of the client searching module 710 in a client 304, 306 and the searching module 410 in the enterprise server 314 shall now be described in greater detail with reference to FIG. 9. The client searching module 710 supports a number of user interfaces for enabling the user to enter a search command. One user interface is a field driven graphical

user interface (GUI) 902. Examples of field driven GUIs 902 are shown in FIGS. 53 and 57."(Column 25, lines 39-42; column 26, lines 60-67).

As per claim 11, Rivette teaches the method wherein the law-firm content is stored in a law-firm information management system (see item 302, Figure 3) that includes a document management system (i.e. document databases)(see Figure 6) for the law firm (i.e. user)(Figure 2) and is separated from the online legal service by a firewall (i.e. Network)(Figure 3).

### ***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Farhan M. Syed whose telephone number is 571-272-7191. The examiner can normally be reached on 8:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christian Chace can be reached on 571-272-4190. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Art Unit: 2165

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